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OCT 03 2006

Serial No. 09/738,591  
60246-116; 8940REMARKS

Claim 1 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner interprets the limitation of having the first roller "resist cooling of the film" as being new matter. The Examiner further states that to "resist cooling of the film" can only be interpreted to mean cooling is prevented and heating of the film is maintained. Respectfully, applicant disagrees. The term "resist" does not only mean to prevent, although "resist" could include preventing cooling. The Examiner's interpretation is contrary to one example in the Applicant's Specification [page 4, 19-20], which states that "the first smaller roller 24 is controlled to prevent the film from cooling too fast." Thus, in Applicant's Specification, the term "resist" is defined in one example as permitting some cooling and does not only mean that cooling is entirely prevented, as the Examiner suggests. Therefore, the Examiner's interpretation of the term "resist" in the claim is contrary to the meaning as understood in the claim and in view of the Specification, and is not new matter. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Claims 1-3, 5, 22, 26, 33-35, 35-39, and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bentley in view of Kaneko and further in view of Barclay, and further in view of Walling and Takagi. Regarding claim 42, the Examiner contends that the rollers 40, 42 of Walling can serve the purposes of the postheater. The Examiner further argues that, given the suggestion of a roller using heat, one would have used the heated upper roller 1' and cooled lower roller 1 of Takagi in place of the rollers 40, 42 of Walling "to provide an improved method of imbedding particles." Respectfully, Applicant disagrees based on the below reasons.

The stated motivation that the combination would "provide an improved method of imbedding particles" is insufficient to support a *prima facie* 103 rejection. The Examiner is attempting to replace actual motivation by stating an opinion that the combination would "provide an improved method of imbedding particles" without providing any basis to support this opinion. The rejection does not give any reasons of how the combination would "provide an improved method of imbedding particles" or even why one would expect to succeed in providing "an improved method of imbedding particles" using the combination. For this reason alone, Applicant respectfully requests that the rejection be withdrawn.

Serial No. 09/738,591  
60246-116; 8940

Additionally, there is no motivation to combine Walling and Takagi because one of ordinary skill in the art would not even have looked to the Takagi reference to embed polar particles on the surface of a film. In Takagi, the heated upper roller 1' is used to melt synthetic resin powder that is then deposited onto the surface of the sheet. Thus, even though the upper roller 1' of Takagi is heated, it does not operate to embed particles within the sheet. Therefore, even if one was looking to improve embedding of the particles of Walling, they would not expect to succeed in improving embedding particles based on Takagi because Takagi does not address the problem of embedding particles in a film. Accordingly, for this additional reason, claim 42 is properly allowable.

Additionally, there is no motivation to combine Walling and Takagi because Walling already includes heated roller 40, 42. The rollers 42, 44 of Walling may, under certain circumstances, serve the purposes of the post-heater 24 so as to effectively carry out the bonding of the particles to the membrane. Thus, Walling already discloses using heated rollers 42, 44 to embed the particles in the sheet, and there would be no benefit to using the heated upper roller 1' and the cooled lower roller 1 of Takagi. Furthermore, since Takagi does not even address the problem of embedding particles, there is no expectation that using the cooled lower roller 1 of Takagi would improve embedding of the particles. For this additional reason, claim 42 is properly allowable.

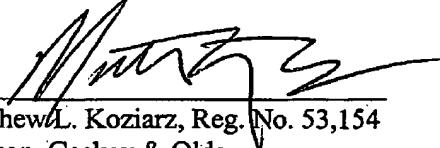
Additionally, the Examiner is using impermissible hindsight to recreate Applicant's invention. Using a heated roller on the side of the film with the particles and another roller on the other side of the film to cool the film is only known through the teachings of Applicant's disclosure. The Examiner is attempting to recreate this feature of Applicant's claim by arbitrarily choosing to substitute the rollers 1', 1 of Takagi for the rollers 40, 42 of Walling without any reason to do so. The mere fact that Takagi discloses a heated roller 1' and a cooled roller 1 for some other purpose besides embedding particles does not mean that one would use the rollers 1', 1 to embed particles, and by no stretch means that using the rollers 1', 1 would "provide an improved method of imbedding particles." Therefore, Applicant respectfully requests that the rejection of claim 42 be withdrawn.

Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson,

Serial No. 09/738,591  
60246-116; 8940

Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,

  
Matthew L. Koziarz, Reg. No. 53,154  
Carlson, Gaskey & Olds  
400 W. Maple Road, Ste. 350  
Birmingham, MI 48009  
(248) 988-8360

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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States patent and Trademark Office, fax number (703) 872-9306, on October 3, 2006.

  
Laura Combs